

REMARKS

Claims 1-46 are pending in this application. Claims 1, 15, 20, 22, 31, and 36 are independent. In light of the remarks contained herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner objected to claim 18; and rejected claims 1-5, 10-16, 19-20, 22, 24-25, 27-29, and 31-34 under 35 U.S.C. § 103(a) as being unpatentable over *Sekendur* (USP 5,852,434) and *Kuzunuki et al.* (USP 5,903,667). Applicants respectfully traverse these rejections.

Applicants wish to thank the Examiner for noting claims 6-9, 17-18, 21, 23, 26, 30, and 35 contain allowable subject matter.

Claim Objections

The Examiner objected to claim 18, asserting when the claim set was reproduced in the Reply filed on May 29, 2003, the phrase "as claimed in claim 15 further comprising" was missing. Included in this Reply is a complete claim set including this phrase as originally filed. It is respectfully requested that the outstanding objection be withdrawn.

Claim Rejections - 35 U.S.C. § 103

With regard to the Examiner's rejection of claim 1, the Examiner admits that *Sekendur* does not teach an address area indicating an address to which the handwritten information is to be

sent wherein the address area comprises an address coding pattern comprising a plurality of second symbols and wherein an arbitrary address portion of a predetermined second size of the address coding pattern unambiguously defines part of the address. The Examiner relies on *Kuzunuki et al.* to cure the deficiencies of the teachings of *Sekendur*, asserting *Kuzunuki et al.* teaches a formatted mail document (Fig. 2) comprising receiver input area G130, transmitter input area G150, item input area G170, and contents input area G190. The Examiner asserts *Kuzunuki et al.* teaches these areas are to be input as handwritten characters and recognized as such, citing to col. 1, lines 52-67. The Examiner further asserts that *Kuzunuki et al.* teaches that data handwritten in transmitter area G150 would be used for transferring the data handwritten in the comment area G210 (Fig. 3; col. 2, lines 1-18). The Examiner further notes *Kuzunuki et al.*'s transmitter area reads on the claimed address area. The Examiner concludes it would have been obvious for one of ordinary skill in the art to provide a transmitter area for transferring the information in the position coded writing area as this allows handwritten information transfer as taught by *Kuzunuki et al.* and, further, the Examiner concludes it would be obvious the same coding format in *Sekendur* can also be used for the transmitter area for address decoding purposes.

Applicants respectfully disagree with the Examiner's characterization of these references.

In order to sustain a claim rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The disclosure set forth in *Kusunuki et al.* is directed to a handwritten input information processing apparatus and handwritten input information system. In discussing the background art, *Kusunuki et al.* mentions a formatted mail document, depicted in Fig. 2, including a receiver input area G130, transmitter input area G150, item input area G170, and contents input area G190. The prior art system recognizes a handwritten character stroke in order to discern the information input in the receiver input area G130. Information that is entered in the common input area G210 is not

transformed into character information but is used directly as a handwritten image comment. (Col. 1, lines 52-67).

There is no teaching or suggestion in the *Kuzunuki et al.* reference directed to an address area comprising an address-coding pattern. As noted above, in order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must provide references that teach or suggest all of the claimed elements. The Examiner admits that *Sekendur* does not teach an address area comprising an address-coding pattern. *Kuzunuki et al.* fails to cure the deficiencies of the teachings of *Sekendur* as there is no discussion in *Kuzunuki et al.* directed to an address area comprising an address-coding pattern. As such, based upon the Examiner's failure to provide a reference that teaches or suggests all of the claimed elements, namely, an address area comprising an address-coding pattern, the Examiner has failed to meet his burden in establishing a *prima facie* case of obviousness. As such, for at least this reason, it is respectfully requested that the outstanding rejection be withdrawn.

Additionally, in support of the Examiner's rejection of claim 1, the Examiner admits that *Sekendur* fails to teach an address-coding pattern comprising a plurality of second symbols wherein an arbitrary address portion of a predetermined second size of the address-coding pattern unambiguously defines part of the address.

While the Examiner asserts *Kusunuki et al.* cures the deficiencies of the teachings of *Sekendur*, the Examiner fails to provide any support in the *Kusunuki et al.* reference that teaches or suggests this claimed element. It is respectfully submitted that *Kusunuki et al.* fails to teach or suggest an address-coding pattern comprising a plurality of second symbols and wherein an arbitrary address portion of a predetermined second size of the address-coding pattern unambiguously defines part of the address. As such, based upon the Examiner's failure to provide a reference that teaches or suggests all of the claimed elements, it is respectfully submitted that the Examiner has failed to meet his burden in establishing a *prima facie* case of obviousness under 35 U.S.C. § 103. At least for this reason, it is respectfully requested that the outstanding rejection be withdrawn.

In providing motivation for the combination of the *Sekendur* and the *Kusunuki et al.* references, the Examiner asserts:

...[I]t is obvious that the same coding format as in *Sekendur* can also be used for the transmitter (address) area for address decoding purpose.

It is respectfully submitted that this statement is insufficient in providing motivation for the combination of these two references. The mere statement that the coding format in *Sekendur* may be used for the transmitter area for area decoding

purposes does not provide sufficient information as to why one of ordinary skill in the art would be motivated to combine the teachings of these two references. Further, as neither of the references teaches an address-coding pattern, the motivation the Examiner arguably provided is not found within these two references. Thus, it is clear that the Examiner has looked to the Applicants' specification in order to provide what he considers to be proper motivation. It is respectfully submitted that this constitutes improper hindsight. The teaching or suggestion to make the asserted combination or modification of the primary reference must be found in the prior art and cannot be gleaned from applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In other words, the use of hindsight to reconstruct the claimed invention is impermissible. *Uniroyal Inc. v. Rudlan-Wiley Corp.*, 5 USPQ 1434 (Fed. Cir. 1983). As such, based upon the Examiner's use of improper hindsight, it is respectfully submitted that the reasons set forth in the outstanding Official Action regarding the motivation to combine these two references is improper and, thus, it is respectfully requested that the outstanding rejection be withdrawn.

Finally, the present invention as set forth in claim 1 provides two coding patterns, a position-coding pattern and an address-coding pattern. It is respectfully submitted that neither

of the references, either alone or in combination, assuming these references are combinable, which Applicants do not admit, teach or suggest two coding patterns. As such, based upon the failure of the Examiner to provide a reference that teaches or suggests all of the claimed elements, it is respectfully submitted that the Examiner has failed to meet his burden in establishing a *prima facie* case of obviousness under 35 U.S.C. § 103. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2-14 and 20 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1.

It is further respectfully submitted that independent claims 15, 20, and 22 contain at least one element that is similar to the elements discussed above with regard to claim 1 and, thus, claims 15, 20, and 22, together with claims dependent thereon, are allowable for the reasons set forth above with regard to claim 1.

In support of the Examiner's rejection of claim 31, the Examiner merely refers to his analysis of claim 1. However, it is respectfully submitted that claim 31 contains elements that are not included in claim 1. For example, claim 31 recites, *inter alia*, a product for electronic transmission of handwritten information comprising a character area provided with a character-encoding pattern consisting of a plurality of symbols unambiguously

representing each character, at least a part of the character encoding pattern being readable to directly identify the characters represented thereby. It is respectfully submitted that Applicants are unclear as to which of the references the Examiner is relying upon to teach or suggest this element. Neither of the references, either alone or in combination, teach or suggest this element. Should the Examiner maintain his rejection of this claim, it is respectfully requested that the Examiner provide a detailed explanation as to what specific reference and what portion of the specific reference the Examiner is relying upon to sustain his *prima facie* case of obviousness under 35 U.S.C. § 103 in a non-final Official Action.

Based upon the failure of the Examiner to provide a reference that teaches or suggests all of the elements set forth in claim 31, it is respectfully submitted that claim 31, together with claims dependent thereon, are patentable over *Sekendur* in view of *Kusunuki et al.*

For all of the above stated reasons, reconsideration and withdrawal of the rejections and allowance of all claims are earnestly solicited.

New Claims

New claims 36-46 have been added by this Reply. It is respectfully submitted that these claims are allowable over the art cited by the Examiner.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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